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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/865,916

05/24/2001

John Rodriguez

LS/0026.00

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7590

02/13/2006

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EXAMINER

GRAYSAY, TAMARA L

ART UNIT

PAPER NUMBER

3636

DATE MAILED: 02/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/865,916

Applicant(s)

RODRIGUEZ

Examiner

Tamara L. Graysay

Art Unit

3636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2005 and 16 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 July 2005 and 16 November 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Compact Disc Submission

1. The amendment filed 28 July 2005 is objected to under 37 CFR 1.52(e)(4) because it does not contain a statement in the transmittal letter that the two compact discs are identical. Correction is required.

Further, only one compact disc was submitted, not two.

2. The amendment filed 28 July 2005 contains data on compact disc(s). Compact disc labeled LS0026-computer-program-listing-appendix.doc is not identified in the transmittal letter and/or the transmittal letter does not list for each compact disc, the machine format, the operating system compatibility, a list of files contained on the compact disc including their names, sizes in bytes, and dates of creation, plus any other special information that is necessary to identify, maintain, and interpret the information on the compact disc as required by 37 CFR 1.52(e)(3). A statement listing the required information is required.

3. The amendment filed 28 July 2005 contains a data file on CD-ROM/CD-R that is not in an ASCII file format. File LS0026-computer-program-listing-appendix.doc that contains non-ASCII characters is not in an ASCII format. Applicant is required to resubmit file(s) in ASCII format as required by 37 CFR 1.52(e)(3). No new matter may be introduced in presenting the file(s) in ASCII format.

Drawings

4. The drawings are objected to because of the following:
 - a. See attached PTO-948 for draftsman objection to FIG. 5C.
 - b. They fail to comply with 37 CFR .184(h)(2) because a smaller scale view should be included showing the whole formed by the partial views and indicating the position of the parts shown. In the present application, FIG.5C (which is itself improper) must also comply with 37 CFR .184(h)(2).
 - c. The fail to comply with 37 CFR 1.84(b)(i) because views 5C are on two or more sheets and are intended to form, in effect, a single complete view, however, the views on the several sheets are not so arranged that the complete figures can be assembled without concealing any part of any other views appearing on the various sheets. In other words, the partial views are to be arranged on the sheets so that when the partial views are taped together to form a complete view no part of any other view is concealed.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

5. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

6. The disclosure is objected to because of the following informalities:

Page 24-25, fails to comply with 37 CFR 1.96(b)(2)(ii) because a computer program listing having more than 60 lines of code that is submitted as part of the specification must be positioned at the end of the description but before the claims.

Although applicant has made a *bona fide* attempt to overcome this objection, it is repeated because the revised computer program listing still has more than 60 lines of code (up to 72 characters per line).

Applicant is reminded that any amendment must be made by way of submission of a substitute sheet.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 7, 10, 16 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Bezos (cited by applicant, US-6029141).

a. Claim 1: Bezos discloses a method for providing assignment of product orders to multiple fulfillers including receiving an order that requires more than one fulfiller (paragraph spanning C.2-3, multiple different sites); ranking the fulfillers based on specified criteria (C.3, L.8-32, an associate recommends selected items); and, splitting the order by assigning fulfillment of items to most-favorable fulfillers that can fulfill the order (paragraph spanning C.2-3, customer shopping cart order is split among items ordered from multiple different sites; C.15, L.51-60 items from merchant or from associate referral).

The preamble recitation “to be performed on a computing device” is a statement of intended use and of no patentable weight because the claim lacks positive recitation of computer hardware or computer hardware in combination with software in the body of the claim and lacks relationship of the steps to computer hardware or computer hardware in combination with software.

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- b. Claim 7: the step of automatically generating a fulfillment request is met by Bezos insofar as the customer places the order at the fulfiller's website via the shopping cart.
 - c. Claim 10: the step of determining desirable attributes is inherent in the fact that, in Bezos, the associate is posting the information about the fulfiller on the website, and in some cases recommending an item offered by the fulfiller.
 - d. Claim 16: the step of automatically generating a fulfillment request is met by Bezos insofar as the customer places the order at the fulfiller's website via the shopping cart.
 - e. Claim 20: Bezos discloses that the fulfiller is a merchant that supplies the items.
8. Claims 1, 6-10, 15, 16 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Spiegelhoff (US-5402336).
- a. Claim 1: Spiegelhoff discloses a method for providing assignment of product orders to multiple fulfillers (suppliers / warehouses) including receiving an order that requires more than one fulfiller (input request from orderer, e.g., abstract, ref.54); ranking the fulfillers based on specified criteria (primary warehouses and secondary warehouses, e.g., C.4); and, splitting the order by assigning fulfillment of items to most-favorable fulfillers that can fulfill the order (item ordered from lowest-price warehouse, Fig.3, C.7, L.4-23).

The preamble recitation "to be performed on a computing device" is a statement of intended use and of no patentable weight because the claim lacks positive recitation of

computer hardware or computer hardware in combination with software in the body of the claim and lacks relationship of the steps to computer hardware or computer hardware in combination with software.

b. Claim 6: Spiegelhoff meets claim 6 insofar as the secondary warehouses are compared to each other “to ensure fairness” in that the lowest-price warehouse is chosen of all secondary warehouses.

c. Claim 7: Spiegelhoff meets the limitation of automatically generating a fulfillment request when the order is placed with the primary or secondary warehouse (C.13).

d. Claim 10: the step of determining desirable attributes is inherent in that Spiegelhoff includes primary and secondary warehouses.

e. Claim 15: Spiegelhoff meets claim 15 insofar as the secondary warehouses are compared to each other “to ensure fairness” in that the lowest-price warehouse is chosen of all secondary warehouses.

f. Claim 16: Spiegelhoff meets the step of automatically generating a fulfillment request insofar as the customer places the order using the edit order file routine.

g. Claim 20: Spiegelhoff discloses that the fulfiller is a supplier.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2-5 and 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spiegelhoff (US-5402336).

Claims 2-5 and 11-14: Spiegelhoff discloses a separate element for adjusting shipping (freight) charges. However, at column 12, lines 24-27 of the reference read that the subroutine for editing shipping charges can be incorporated into the edit warehouse routine. Spiegelhoff discloses minimizing costs; however, it does not specifically address minimization of shipping costs relative to any particular party to the transaction.

The examiner takes Official Notice that minimizing costs is old and well established in the retail business as a way to increase profitability.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Spiegelhoff to include minimizing shipping costs by taking the shipping costs into consideration when assigning fulfillment of an order because the skilled artisan would have recognized that this business practice increases profits.

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10. Claims 8, 9 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bezos (cited by applicant, US-6029141) in view of ATIS (hash function definition).

a. Claims 8 and 9: ATIS teaches that a hash function is one that maps values from a large domain into a smaller range. A hash table is a well known in-memory data structure expedient that is used in order to easily and quickly locate stored information in a computer memory.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Bezos to include a hash table to indicate which fulfiller can fulfill the particular type of items, i.e., associating various items that may be ordered to the various fulfillers.

b. Claims 17-19: ATIS teaches that a hash function is one that maps values from a large domain into a smaller range. A hash table and an associated index are well known in-memory data structure expedients that are used in order to easily and quickly locate stored information in a computer memory.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Bezos to include a hash table and associated index to indicate which fulfiller can fulfill the particular type of items, i.e., associating various items that may be ordered to the various fulfillers.

11. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spiegelhoff (US-5402336) in view of ATIS (hash function definition).

a. Claims 8 and 9: ATIS teaches that a hash function is one that maps values from a large domain into a smaller range. A hash table is a well known in-memory data structure expedient that is used in order to easily and quickly locate stored information in a computer memory.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Spiegelhoff to include a hash table to indicate which fulfiller can fulfill the particular type of items, i.e., associating various items that may be ordered to the various fulfillers.

b. Claims 17-19: ATIS teaches that a hash function is one that maps values from a large domain into a smaller range. A hash table and an associated index are well known in-memory data structure expedients that are used in order to easily and quickly locate stored information in a computer memory.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Spiegelhoff to include a hash table and associated index to indicate which fulfiller can fulfill the particular type of items, i.e., associating various items that may be ordered to the various fulfillers.

Response to Arguments

10. Applicant's arguments filed 28 July 2005 and 16 November 2005 have been fully considered but they are not persuasive.

a. Applicant's arguments with respect to claims 7, 8 and 17-19 have been considered but are moot in view of the new ground(s) of rejection.

b. In response to applicant's argument at the top of page 16 (28 July 2005 reply) that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., claim 1 does not include "the purpose of the invention is to select fulfillers based on numerous available options for items in a single order") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

c. In response to applicant's argument that Bezos does not disclose splitting an order by assigning fulfillment as recited in claim 1, the examiner disagrees insofar as Bezos does include the method step as mentioned in the rejection above. The preamble is limited to an embodiment that is "to be performed on a computing device." First, all steps are not related to the computer and can be performed in the manner set forth in Bezos, which discloses assigning fulfillment to more than one supplier. Second, the user in Bezos is a user's single order that is split among fulfillers (suppliers).

d. In response to applicant's argument that Bezos fails to disclose assigning the order to a subset of most favorable fulfillers as recited in claim 10, the examiner disagrees insofar as Bezos does include a user that assigns the order to a subset (part of the complete order assigned to various suppliers) of fulfillers most favorable for the user. The most favorable being those that supply the user's desired items.

e. In response to applicant's argument that Spiegelhoff does not disclose splitting the order or assigning a subset, the examiner disagrees insofar as Spiegelhoff includes orders having multiple fulfillers as discussed above.

f. Furthermore, it is well settled that it is not "invention" to broadly provide a mechanical or automatic means to replace manual activity which has accomplished the same result. In re Venner, 120 USPQ 192. The process steps are known business tools for ensuring timely and consistent order fulfillment and automating that decision making process is not invention.

Conclusion

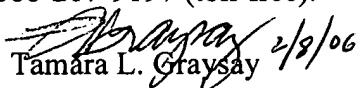
11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamara L. Graysay whose telephone number is 571-272-6728. The examiner can normally be reached on Mon - Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Cuomo, can be reached on 571-272-6856. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Tamara L. Graysay 2/8/06
Examiner
Art Unit 3636